

REMARKS

STATUS OF THE CLAIMS

Claims 16 and 24-31 were pending. Claims 1 and 25 have been amended. New claim 32 has been presented. Claims 16 and 24-32 would be pending in the application if the instant amendment is entered.

I. REJECTION UNDER 35 U.S.C. § 102(e) - McClure '397

The Examiner has rejected claims 16 and 24-26 under 35 U.S.C. § 102(e) as allegedly being anticipated by McClure ('397; U.S. Patent No. 6,329,397). The Examiner stated that there were three N-hydroxyl piperidine amides in McClure '397, Examples 34 and 35, and (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide (col. 102, lines 22-24), that anticipated claims 16 and 24-26.

Applicants respectfully submit that the claims, as amended, and new claim 32 are not anticipated by McClure '397. The Examiner has stated that the N-hydroxyl piperidine amides Examples 34 and 35, and (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide of McClure '397 fall within the scope of claims 16 and 24-26. Claim 25 has been canceled. Claim 26 is now dependent on the new independent claim 32. Claim 16 has been amended to recite that X is N. Claim 24 is dependent on claim 16. Therefore claim 16, as amended, encompasses the use of compounds of formula I where X is N. However, X is carbon in Examples 34 and 35, and (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide of McClure '397. Therefore, Example 34, Example 35, and (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide of McClure '397 each do not anticipate claim 16 or claim 24.

New claim 32 recites, in part, that X is carbon, "R⁵ and R⁶ are independent substituents in the ortho, meta, or para positions and are independently selected from the group consisting of hydrogen, halogen, cyano, and ethyl," and that "R⁵ is para-halo, then at least one of R⁶, R³, and R⁴ is not hydrogen." In Examples 34 and 35 of McClure '397, X is carbon, and R⁵ is a para-halo (fluoro), however all of R⁶, R³, and R⁴ are hydrogen. Therefore, Examples 34 and 35 of McClure '397 do not anticipate claim 32. The

compound (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide of McClure '397 has a methyl as R⁵. However, claim 32 does not permit a methyl at R⁵. Therefore, (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide does not anticipate claim 32. Accordingly, Examples 34 and 35, and (2R,3R,5R)-5-Hydroxy-3-methyl-1-[4-(2-methyl-benzyloxy)-benzenesulfonyl]-piperidine-2-carboxylic acid hydroxyamide of McClure '397 each do not exhibit all of the limitations of the claimed invention. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be withdrawn.

II. REJECTION UNDER 35 U.S.C. § 103(a)- McClure '397

The Examiner has rejected claims 16 and 24-26 under 35 U.S.C. § 103(a) as allegedly being obvious in view of McClure ('397; U.S. Patent No. 6,329,397). The Examiner stated that McClure '397 is a 35 U.S.C. § 102(e) reference.

Applicants assert that McClure '397 is not available as a 35 U.S.C. § 102(e) reference to support a rejection under 35 U.S.C. § 103(a) because of 35 U.S.C. § 103(c). Under 35 U.S.C. § 103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

The undersigned, who is an attorney of record in Application 09/635,433 states that:

Application 09/635,433 and U.S. Patent No. 6,329,397 were, at the time of invention of Application 09/635,433 was made, owned by Pfizer Inc.

Accordingly, under 35 U.S.C. § 103(c) McClure '397 is not available as a 35 U.S.C. § 102(e) reference to support a rejection under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request that the rejection of claims 16, and 25-26 under 35 U.S.C. § 103(a) be withdrawn.

III. REJECTION UNDER 35 U.S.C. § 103(a) - McClure '397

The Examiner has rejected claim 27 under 35 U.S.C. § 103(a) as allegedly being obvious over McClure ('397; U.S. Patent No. 6,329,397).

Applicants assert that McClure '397 is not available as a 35 U.S.C. § 102(e) reference to support a rejection of claim 27 under 35 U.S.C. § 103(a) because of 35 U.S.C. § 103(c) as set out above in section II. Accordingly, Applicants respectfully request that the rejection of claim 27 under 35 U.S.C. § 103(a) be withdrawn.

IV. REJECTION FOR NON-STATUTORY DOUBLE PATENTING- McClure '397

The Examiner has rejected claims 16, and 24-27 for non-statutory obviousness-type double patenting over claim 68 of U.S. Patent No. 6,329,397.

Applicants maintain that this rejection should be withdrawn in view of the submission of a terminal disclaimer on May 12, 2004 in compliance with 37 C.F.R. § 1.321(c) to over come this rejection. Accordingly, Applicants respectfully request that the obviousness type double patenting rejection of claims 16 and 24-27 over McClure '397 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance is respectfully requested.

If the Examiner believes that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at 734-622-2095.

Respectfully submitted,

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